

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

SIGHT SCIENCES, INC.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	C.A. No. 21-1317-GBW-SRF
	)	
IVANTIS, INC., ALCON RESEARCH	)	
LLC, ALCON VISION, LLC, and ALCON	)	
INC.,	)	
	)	
Defendants.	)	

**DEFENDANTS' CONCISE STATEMENT OF FACTS IN SUPPORT OF THEIR  
MOTION FOR SUMMARY JUDGMENT OF INVALIDITY FOR  
OBVIOUSNESS-TYPE DOUBLE PATENTING**

OF COUNSEL:

Gregg LoCascio  
Sean McEldowney  
Justin Bova  
Steven Dirks  
Socrates L. Boutsikaris  
KIRKLAND & ELLIS LLP  
1301 Pennsylvania Avenue, N.W.  
Washington, DC 20004  
(202) 389-5000

Jeanne M. Heffernan  
Kat Li  
Ryan J. Melde  
KIRKLAND & ELLIS LLP  
401 Congress Avenue  
Austin, TX 78701  
(512) 678-9100

Ryan Kane  
Nathaniel DeLucia  
Emily Sheffield  
KIRKLAND & ELLIS LLP  
601 Lexington Avenue  
New York, NY 10022  
(212) 446-4800

John W. Shaw (No. 3362)  
Karen E. Keller (No. 4489)  
Andrew E. Russell (No. 5382)  
Nathan R. Hoeschen (No. 6232)  
SHAW KELLER LLP  
I.M. Pei Building  
1105 North Market Street, 12th Floor  
Wilmington, DE 19801  
(302) 298-0700  
jshaw@shawkeller.com  
kkeller@shawkeller.com  
arussell@shawkeller.com  
nhoeschen@shawkeller.com  
*Attorneys for Defendants*

Brian A. Verbus  
Jacob Rambeau  
KIRKLAND & ELLIS LLP  
300 N. LaSalle  
Chicago, IL 60654  
(312) 862-2000

Noah Frank  
KIRKLAND & ELLIS LLP  
200 Clarendon Street  
Boston, MA 02116  
(617) 385-7500

Dated: October 12, 2023

1. U.S. Patent No. 8,287,482 (“’482 Patent”) issued from Application No. 12/695,053, filed January 27, 2010, and is a continuation of application No. 11/475,523, filed June 26, 2006, now U.S. Patent No. 7,909,789 (“’789 Patent”). Ex. 1, ’482 Patent, cover; Appendix Y. The ’482 Patent is subject to patent term adjustments of 305 days under 35 U.S.C. § 154(b) and expires on April 27, 2027. Ex. 1, ’482 Patent, cover; Ex. 10, Jarosz Op. Rep. at ¶27; Appendix Y.

2. U.S. Patent No. 9,370,443 (“’443 Patent”) issued from Application No. 13/025,112, filed February 10, 2011, and is a divisional of the ’789 Patent. Ex. 2, ’443 Patent, cover; Appendix Y. The ’443 Patent is subject to patent term adjustments of 868 days under 35 U.S.C. § 154(b) and expires on November 10, 2028. Ex. 2, ’443 Patent, cover; Ex. 10, Jarosz Op. Rep. at ¶28; Appendix Y.

3. U.S. Patent No. 9,486,361 (“’361 Patent”) issued from Application No. 13/445,816, filed June 12, 2012, is a continuation of application No. 12/695,053, filed January 27, 2010, now U.S. Patent No. 8,287,482 (“’482 Patent”), which is a continuation of the ’789 patent. Ex. 3, ’361 Patent, cover; Appendix Y. The ’361 Patent is subject to patent term adjustments of 577 days under 35 U.S.C. § 154(b) and expires on January 24, 2028. Ex. 3, ’361 Patent, cover; Ex. 10, Jarosz Op. Rep. at ¶29; Appendix Y.

4. U.S. Patent No. 10,314,742 (“’742 Patent”) issued from Application No. 15/182,165, filed June 14, 2016, and is a continuation of the ’443 Patent. Ex. 4, ’742 Patent, cover; Appendix Y. The ’742 Patent is subject to patent term adjustments of 329 days under 35 U.S.C. § 154(b), and a terminal disclaimer, and expires on May 21, 2027. Ex. 4, ’742 Patent, cover; Ex. 10, Jarosz Op. Rep. at ¶31; Appendix Y.

5. During prosecution of the '742 Patent, Sight filed a terminal disclaimer to overcome the Examiner's double patenting rejection, disclaiming the terminal part of the '742 Patent's term, which would extend beyond the expiration dates of the '361 and '443 Patents. Ex. 6, '742 Patent File History at August 9, 2018 Non-Final Rejection; Ex. 7, '742 Patent File History at December 10, 2018 Response to Non-Final Office Action.

6. U.S. Patent No. 11,389,328 ("328 Patent") issued from Application No. 16/413,466, filed May 15, 2019, and is a continuation of the '742 Patent. Ex. 5, '328 Patent, cover; Appendix Y. The '328 Patent is subject to patent term adjustments of 656 days under 35 U.S.C. § 154(b), and a terminal disclaimer, and expires on May 21, 2027. Ex. 5, '328 Patent, cover; Ex. 10, Jarosz Op. Rep. at ¶33; Appendix Y.

7. During prosecution of the '328 Patent, Sight filed a terminal disclaimer to overcome the Examiner's double patenting rejection, disclaiming the terminal part of the '328 Patent's term, which would extend beyond the expiration dates of the '361, '443, '742, and '789 Patents. Ex. 8, '328 Patent File History at April 26, 2022 Non-Final Rejection; Ex. 9, '328 Patent File History at May 19, 2022 Response to Non-Final Office Action.

8. Defendants filed petitions for *inter partes* review ("IPR") against the '361 and '443 Patents. Ex. 62, IPR2022-01540, Paper 2 (Petition) at 1; Ex. 61, IPR2022-01529, Paper 2 (Petition) at 1.

9. Sight stated to the Board that the Board should exercise its discretion to deny institution of Defendants' IPRs under 35 U.S.C. § 325(d) because the same or substantially the same prior art was previously presented to the Patent Office. Ex. 64, IPR2022-01540, Paper 6 (POPR) at 9–13, 22–24; Ex. 63, IPR2022-01529, Paper 6 (POPR) at 14–21.

10. Sight represented to the Board that the claims of the '361 and '443 Patents were of “similar scope” to the '328 and '742 Patents, charted exemplary claims of the '361, '443, '328 and '742 Patents, and pointed to the Examiner’s determination during prosecution of the '328 and '742 Patents that claims of the '328 and '742 Patents were “not patentably distinct from” claims of the '361 and '443 Patents. Ex. 63, IPR2022-01529, POPR at 19–21; Ex. 64, IPR2022-01540, POPR at 22–24.

OF COUNSEL:

Gregg LoCascio  
Sean M. McEldowney  
Justin Bova  
Steven Dirks  
Socrates L. Boutsikaris  
KIRKLAND & ELLIS LLP  
1301 Pennsylvania Avenue, N.W.  
Washington, DC 20004  
(202) 389-5000

Jeanne M. Heffernan  
Kat Li  
Ryan J. Melde  
KIRKLAND & ELLIS LLP  
401 Congress Avenue  
Austin, TX 78701  
(512) 678-9100

Ryan Kane  
Nathaniel DeLucia  
Emily Sheffield  
KIRKLAND & ELLIS LLP  
601 Lexington Avenue  
New York, NY 10022  
(212) 446-4800

Brian A. Verbus  
Jacob Rambeau  
KIRKLAND & ELLIS LLP  
300 N. LaSalle  
Chicago, IL 60654  
(312) 862-2000

Noah S. Frank  
KIRKLAND & ELLIS LLP  
200 Clarendon Street  
Boston, MA 02116  
(617) 385-7500

Dated: October 12, 2023

/s/ Andrew E. Russell

John W. Shaw (No. 3362)  
Karen E. Keller (No. 4489)  
Andrew E. Russell (No. 5382)  
Nathan R. Hoeschen (No. 6232)  
SHAW KELLER LLP  
I.M. Pei Building  
1105 North Market Street, 12th Floor  
Wilmington, DE 19801  
(302) 298-0700  
jshaw@shawkeller.com  
kkeller@shawkeller.com  
arussell@shawkeller.com  
nhoeschen@shawkeller.com  
*Attorneys for Defendants*

**CERTIFICATE OF SERVICE**

I, Andrew E. Russell, hereby certify that on October 12, 2023, this document was served on [zsightsciencesivantis@cooley.com](mailto:zsightsciencesivantis@cooley.com) and the persons listed below in the manner indicated:

**BY EMAIL**

Melanie K. Sharp  
James L. Higgins  
Taylor E. Hallowell  
YOUNG, CONAWAY, STARGATT & TAYLOR LLP  
Rodney Square  
1000 North King Street  
Wilmington, DE 19801  
(302) 571-6600  
[msharp@ycst.com](mailto:msharp@ycst.com)  
[jhiggins@ycst.com](mailto:jhiggins@ycst.com)  
[thallowell@ycst.com](mailto:thallowell@ycst.com)

Orion Armon  
COOLEY LLP  
1144 15th Street, Suite 2300  
Denver, CO 80202  
(720) 566-4000  
[oarmon@cooley.com](mailto:oarmon@cooley.com)

Dustin M. Knight  
Joseph Van Tassell  
COOLEY LLP  
11951 Freedom Drive, 14<sup>th</sup> Floor  
Reston, VA 20190  
(703) 456-8024  
[dknight@cooley.com](mailto:dknight@cooley.com)  
[jvantassell@cooley.com](mailto:jvantassell@cooley.com)

Michelle S. Rhyu, J.D., Ph.D.  
Lauren Strosnick  
Alissa Wood  
Angela R. Madrigal  
Juan Pablo Gonzalez  
Jeffrey Karr  
COOLEY LLP  
3175 Hanover Street  
Palo Alto, CA 94305  
(650) 843-5000  
[rhyums@cooley.com](mailto:rhyums@cooley.com)  
[lstrosnick@cooley.com](mailto:lstrosnick@cooley.com)  
[amwood@cooley.com](mailto:amwood@cooley.com)  
[jgonzalez@cooley.com](mailto:jgonzalez@cooley.com)  
[amadrigal@cooley.com](mailto:amadrigal@cooley.com)  
[jkarr@cooley.com](mailto:jkarr@cooley.com)

Bonnie Fletcher Price  
COOLEY LLP  
1299 Pennsylvania Avenue, NW  
Suite 700  
Washington, DC 20004  
(202) 776-2099  
[bfletcherprice@cooley.com](mailto:bfletcherprice@cooley.com)

/s/ Andrew E. Russell

---

John W. Shaw (No. 3362)

Karen E. Keller (No. 4489)

Andrew E. Russell (No. 5382)

Nathan R. Hoeschen (No. 6232)

SHAW KELLER LLP

I.M. Pei Building

1105 North Market Street, 12th Floor

Wilmington, DE 19801

(302) 298-0700a

jshaw@shawkeller.com

kkeller@shawkeller.com

arussell@shawkeller.com

nhoeschen@shawkeller.com

*Attorneys for Defendants*



